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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/203,672	12/01/1998	JIANGTAO WEN	Q48591	4494

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EXAMINER
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AN, SHAWN S

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/203,672	<b>Applicant(s)</b> WEN ET AL.	
	<b>Examiner</b> Shawn S. An	<b>Art Unit</b> 2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 12 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. As per Applicant's instructions as filed on 2/13/06, claims 11 and 14 have been amended, claims 1-10 have been canceled, and claims 15-16 have been newly added.

### *Response to Remarks*

2. Applicant's remarks as filed on 2/13/06 have been fully considered but they are not persuasive.

The Applicants present arguments that the Examiner is impermissibly intermixing the functions of the COD with the functions of the MODB to find attributes of the claimed COD field, and that the DECISION ON APPEAL expressly addressed this issue.

However, after careful scrutiny of the cited Suzuki reference, the Examiner must respectfully disagree, and maintain the grounds of rejection for the reasons that follow.

In response to Applicant's arguments, the DECISION ON APPEAL is based on the previous 35 USC 102 rejection. However, current rejection is based on **35 U.S.C. 103(a)**, which is a rejection based on obviousness, which is clearly different than the 35 USC 102 rejection. Therefore, Applicant's assertion that similar analysis of the previous 35 USC 102 rejection can be applied to the current rejection is not considered a fair assessment/evaluation of the currently rejected claims.

Furthermore, as per Applicant's arguments regarding that the Examiner is impermissibly intermixing the functions of the COD with the functions of the MODB to find attributes of the claimed COD field, as previously discussed, Suzuki et al discloses all of the COD field (COD flag) with the exceptions of bit value of "11" indicating neither the MV nor the DCT value being encoded, bit value of "00" indicating both the MV and the DCT being encoded, bit value of "01" indicating only MV being encoded.

However, Suzuki et al does disclose a code field (MODB flag) having bit value of "00" indicating neither the MV nor the DCT value being encoded, and another code field (MODB flag) having bit value of "11" indicating both the MV and the DCT being

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encoded, and yet another code field (MODB flag) having bit value of "10" indicating only MV being encoded (col. 34, lines 41-67; col. 35, lines 1-8).

Therefore, knowing that COD (a flag for specifying whether I or P picture macroblock is a skip macroblock) and MODB (a flag for specifying whether B picture macroblock is a skip macroblock) are very similar code flags and similarly variable length coded for transmission, it would have been considered an obvious design choice to a person of skill in the relevant art employing a method for transmission as taught by Suzuki et al to modify the labeling (changing only the nominal sequence of code fields/flags) of the code fields/flags such that the COD field having a bit value of "11" indicates neither the MV nor the DCT value are encoded, the COD field having a bit value of "00" indicates both the MV and the DCT are encoded, and the COD field having a bit value of "01" indicates only the MV is encoded, so as long as functions, in which the COD fields/flags represent, remain substantially the same.

Henceforth, Applicant's argument that the Examiner is impermissibly intermixing the functions of the COD with the functions of the MODB to find attributes of the claimed COD field is not considered correct at least in view of the reasons based on 35 U.S.C. 103(a) (obviousness) as discussed above.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (6,097,842) as previously discussed in the last Office action as filed on 8/11/05.

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5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (6,097,842).

As per newly added claim 15, Suzuki discloses the extended code field being used in H.263 or MPEG-4 encoding standards (col. 34, line 35; col. 41, lines 19-24).

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (6,097,842) in view of Pandel (5,719,631) as previously discussed in the last Office action as filed on 8/11/05.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (6,097,842) in view of Pandel (5,719,631).

As per newly added claim 16, Suzuki discloses the extended code field being used in H.263 or MPEG-4 encoding standards (col. 34, line 35; col. 41, lines 19-24).

#### ***Allowable Subject Matter***

8. Claims 12-13 are objected to as being dependent upon rejected base claim 11, but would be allowable: if claim 12 is rewritten in independent form including all of the limitations of the base claim 11 and any intervening claims.

**Dependent claims 12-13** recite a novel feature, wherein the prior art of record fails to anticipate or make obvious the novel feature.

Accordingly, if the amendments are made to the claims listed above, and if rejected claims are canceled, the application would be placed in a condition for allowance.

#### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Shawn S. An* whose telephone number is 571-272-7324.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**SHAWN AN**  
**PRIMARY EXAMINER**

4/22/06